

AMENDMENTS TO THE DRAWINGS

Applicant submits herewith two replacement drawing sheets for FIGS. 3D and 4C. No new matter has been added by way of this amendment.

In the description of FIGS. 3A-3F, Applicant's specification refers to both modules 310-312 and modules 210-212, while FIGS. 3A-3C and 3E-3F include reference numbers 310-312 to refer to the modules. The amendments to the specification provided above correct the inadvertent reference to modules "210-212" in the description of FIGS. 3A-3F. In addition, in the attached replacement sheet for FIGS. 3A-3F, the reference number "212" in FIG. 3D has been replaced by the reference number "312."

In addition, Applicant's specification refers lead connection devices 313 in the description of FIGS. 3A-3F. However, the reference number "313" was inadvertently omitted from FIGS. 3A-3F. FIGS. 3A-3F have been amended to include the reference number 313.

Applicant's specification refers to an "overmold 422" and "angle of interface 442" in the description of FIG. 4C. However, in FIG. 4C, the reference number "443" was inadvertently used to refer to both the overmold and the angle of interface. FIG. 4C has been amended such that the reference number corresponding to the angle of interface is "442," and the reference number corresponding to the overmold is "422."

REMARKS

This Amendment is responsive to the Office Action dated December 11, 2006. Applicant has amended claims 1, 4-6, 15, 19, 22, and 23, cancelled claims 3, 21, 26, and 27, and added claim 28. Claims 1, 2, 4-20, 22-25, and 28 are pending.

Allowable Subject Matter

In the Office Action, the Examiner indicated that claim 25 is allowable in its present form, and objected to claims 6, 15-17, and 23 as being dependent on a rejected base claim, but including subject matter that would be allowable if rewritten in independent form. In this Amendment, Applicant has amended claims 6, 15-17, and 23 to include all subject matter recited by the base claims and any intervening claims on which these claims depend. Consequently, claims 6, 15-17, and 23 are in condition for allowance.

Restriction Under 35 U.S.C. § 121

In the Office Action, the Examiner restricted claims 1-27 under 35 U.S.C. § 121 as follows:

Group I. Claims 1-25, drawn to an implantable medical device, classified in class 607, subclass 36; and

Group II. Claims 26-27, drawn to a method, classified in class 128, subclass 899.

During a telephonic conversation with the Examiner Reidel on December 7, 2006, Applicant's representative, Jason D. Kelly, provisionally elected Group I (claims 1-25) without traverse. Applicant affirms this election without traverse. Claims 26 and 27 have been cancelled pursuant to the Restriction Requirement.

Objection to the Drawings

The Office Action set forth objections to the drawings. With the present Amendment, Applicant has submitted replacement drawings sheets for FIGS. 3A-3F and 4A-4C to address some of the objections. With respect to one of the objections to the failure of the drawings to show the reference numbers "310," "311," "312," and "442," which are used in the written description, Applicant has amended FIG. 4C to include reference number "442." However,

Applicant notes that the remaining reference numbers “310,” “311,” and “312” are present in FIGS. 3A, 3C, and 3D. Applicant respectfully requests that the objections to the drawings be withdrawn in view of the arguments herein and the attached replacement drawing sheets.

Objection to the Specification

The Office Action set forth objections to the specification on the basis of inadvertent typographical errors. With the present Amendment, Applicant has amended multiple paragraphs of the specification to correct the informalities identified by the Office Action in addition to inadvertent errors identified by the Applicant. Withdrawal of the objection to the specification is respectfully requested.

Claim Rejections Under 35 U.S.C. §§ 102(b) and 103(a)

In the Office Action, claims 1-3, 7, 8, 10 and 19-21 were rejected under 35 U.S.C. § 102(b) as being anticipated by Singer et al. (U.S. Patent No. 5,638,832). Claims 1-3, 11, 13, 14 and 19-21 were rejected under 35 U.S.C. § 102(b) as being anticipated by Meltzer (U.S. Patent No. 5,645,586). Claims 1-3, 7, 18-21 and 24 were also rejected under 35 U.S.C. § 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Probst et al. (U.S. Patent No. 7,103,415). Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Singer et al, and claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Meltzer in view of Sanders (U.S. Patent No. 5,554,194).

Applicant respectfully traverses the rejections to the extent such rejections may be considered applicable to the amended claims. The cited references fail to disclose or suggest each and every feature of the claimed invention, as required by 35 U.S.C. §§ 102(b) and 103(a), and provide no teaching that would have suggested the desirability of modification to include such features.

In order to expedite prosecution of the present application, Applicant has amended independent claims 1 and 19 to clarify that the overmold comprises a first component that at least partially encapsulates each of the housings of the modules and second and third components that are located adjacent to at least one side surface of a respective one of the housings of the modules. In addition, claims 1 and 19 as amended require that at least one of the second and

third components at least one of comprises or is coupled to the motion reduction element or the means for reducing relative motion between at least two of the modules. Applicant notes that in making the present amendments to the claims, Applicant in no way acquiesces to or agrees with the rejection of claims presented in the Office Action or the interpretation given to the cited references in the Office Action. On the contrary, Applicant traverses the rejections and reserves the right to resubmit canceled and/or additional claims in a subsequent continuation application.

The cited references fail to teach at least the added features of independent claims 1 and 19. For example, as the Office Action stated, Singer et al. only discloses that, “the modules 12 and 14 and the motion reduction element 20 may be located inside a biologically-insert capsule” (Office Action at page 5, citing col. 2, ll. 51-55 of Singer et al.) Nothing in Singer et al. teaches or suggests that the biologically-insert capsule may include different components. Furthermore, nothing in Singer et al. even suggests that the medical device includes both a housing and an overmold. Similarly, Meltzer only teaches a coating for an implantable medical device (see Office Action at page 6; Meltzer, col. 4, ll. 44-48), and does not teach or suggest the structural components of the overmold recited in Applicant’s claims 1 and 19. Probst et al. teaches a housing 36, which the Office Action interpreted to be an overmold (Office Action at page 7, item 16), but Probst et al. does not teach or suggest the structural components of the overmold recited in Applicant’s claims 1 and 19.

Singer et al., Meltzer, and Probst et al. each fail to disclose or suggest each and every limitation set forth in amended claims 1 and 19. Claims 2, 3, 7-14, and 18 depend from claim 1 and are allowable therewith. Similarly, claims 20, 21, and 24 depend from claim 19 and are allowable therewith. For at least these reasons, the Examiner has failed to establish a prima facie case nonpatentability of Applicant’s claims 1-3, 7-14, 18-21, and 24 under 35 U.S.C. §§ 102(b) and 103(a). Withdrawal of these rejections is respectfully requested.

Rejection for Obviousness-type Double Patenting:

Claims 1-5, 18-22 and 24 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8, 10-34, 36-45, 47-49, 51, 53-56 and 60-66 of copending Application No. 10/730,873. Claims 1-5, 18-22 and 24 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 and 33-57 of copending Application No. 10/731,869. Claims 1-5, 18-22 and 24 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-15 and 17-25 of copending Application No. 10/731,699. Finally, claims 1-5, 18-22 and 24 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 10/731,638.

Applicant submits herewith a terminal disclaimer overcoming the rejection over claims - 8, 10-34, 36-45, 47-49, 51, 53-56 and 60-66 of Application No. 10/730,873. Applicant respectfully suggests that the terminal disclaimer overcome the obviousness-type double patenting rejection in view of Application No. 10/730,873.

Applicant respectfully traverses the remaining provisional rejections in view of Application Nos. 10/731,869, 10/731,638, and 10/731,699. Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness-type double patenting. To support an obviousness-type double patenting rejection, the Examiner must assess the differences between the claims in the pending application and the claims in the issued patent (or in the present case, in the co-pending patent applications). *In re Berg*, 46 USPQ2d 1226, 1229 (Fed Cir. 1998). In particular, the Examiner should indicate why the claims in an application are obvious over the claims in the granted patent. *Id.*

With respect to the provisional rejections in view of Application Nos. 10/731,869, 10/731,638, and 10/731,699, the Examiner concluded that, “although the conflicting claims are not identical, they are not patentably distinct from each other because the current claims are either a broadening of the scope of the claims of [Application Nos. 10/731,869, 10/731,638, and 10/731,699] or an obvious variant thereof.” (Office Action at pages 9-11, items 23-26.) However, no explanation was offered for how the claims of the present application broaden the

scope of the claims of the cited applications, or why the claims of present application are an obvious variant of the claims of the cited applications.

Nothing in the claims of Application Nos. 10/731,869, 10/731,638, and 10/731,699 recite a motion reduction element. Applicant respectfully submits that the Examiner has failed to clarify the reasons why one skilled in the art would conclude that the invention defined in the claims at issue would have been an obvious variation of the invention defined in the claims of Application Nos. 10/731,869, 10/731,638, and 10/731,699, as required by Section 804 of the MPEP.

For example, with respect to the rejection of Applicant's independent claim 1 over independent claim 1 of copending Application No. 10/731,638, the Examiner failed to provide any reason why an implantable medical device comprising a motion reduction element to reduce intermodule motion would have been obvious in view of the programmer recited in claim 1 of Application No. 10/731,638, which does not even recite a motion reduction element.

Specifically, claim 1 of Application No. 10/731,638 recites:

An implantable medical device for implantation in the head of a patient comprising:

a first module including a first module housing and first operative component within the first module housing;

a second module including a second operative component; and

a flexible overmold that covers the second module and partially covers the first module wherein the first module housing extends out of the overmold for receipt in a first recess in a cranium of a patient.

The claims of Applicant Nos. 10/731,869 and 10/731,699 similarly fail to recite a motion reduction element. The rejection for obviousness-type double patenting should be withdrawn. If the Examiner maintains the obviousness-type double patenting rejection, however, Applicants respectfully request clarification of the grounds of rejection.

New Claims:

Applicant has added claim 28 to the pending application. The applied references fail to disclose or suggest the inventions defined by Applicant's new claim 28, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention. As one example, the references fail to disclose or suggest an implantable medical device comprising an overmold that at least partially encapsulates housings of interconnected modules, where the

overmold comprises a first component comprising an elastomeric material and a second component comprising a nonelastomeric material, as recited by claim 28. No new matter has been added by the new claim.

CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

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